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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Bonner-Weir et al.
Serial No. : 09/602,508
Filed : June 23, 2000
Title : METHODS OF MAKING PANCREATIC ISLET CELLS

Art Unit : 1651
Examiner : V. Afremova

Commissioner for Patents
Washington, D.C. 20231

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RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the action mailed July 2, 2002, applicant elects the invention of Group I, claims 14-26 and 29-40. The restriction requirement is respectfully traversed for the following reasons.

A proper requirement for restriction requires two conditions. The inventions must be independent (i.e., unconnected in design, operation or effect) or distinct (i.e., related but novel and unobvious over each other) and there must be a serious burden on the Examiner if restriction is required. See MPEP §803. The Examiner states that the groups are distinct because:

- they require different active steps which encompasses the use of different cellular materials as claimed. The starting material in the Group I method is “pancreatic duct or exocrine cells”[...] and the starting material in the group II method is “adult or differentiated pancreatic cells substantially free of islet cells.”

In fact, group I and group II do not recite sources of cellular material that are “independent” or “distinct” under the above-mentioned standard for restriction. The Examiner is reminded that pancreatic duct cells and pancreatic exocrine cells (sometimes referred to as acinar cells) (Group I) are 2 types of “differentiated pancreatic cells” (Group II). The third type of differentiated pancreatic cells are islet cells. Thus, Group I and II are different only in that the

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starting material cells of claim 41 recited in step (i) are "substantially free of islet cells" while the starting material cells of claim 29 in step (a) are not so limited.

Furthermore, the Examiner has provided no evidence that groups I and II would have a separate status in the art or a different field of search. Therefore, the Examiner has not established that a serious burden would be involved in searching groups I and II together. Accordingly, Applicants respectfully request that group II be reclassified with group I and that groups I and II be examined together.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: August 2, 2002.

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